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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 16

Application Number: 09/224,913
Filing Date: 01/04/99
Appellant(s): Jaacobus W. Vallen

Bernard Franzblau
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 1/9/01.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

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A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is deficient because element numbers should refer to the specification by page and lines, respectively.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 3-5 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

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The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

US 5,153,550	Sugiura et al.	October 6, 1992
US 4,363,014	Leach et al.	December 7, 1982
US 4,291,292	Witchger	September 1981

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Witchger [US 4,291,292] in view of Sugiura et al..

Witchger discloses an electric coil assembly [see figure 11] comprising:

- a rectangular bobbin [see column 2, lines 9-10] having end flanges [13, 14];
- a coil winding [12] wound about the bobbin; and

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- a synthetic resin cover [31] including an external insulative portion [21, 22] integrally formed with the cover for covering lead wires [21A, 22A] and end portions [see figures 8 and 9];

wherein the cover engages the bobbin and wraps around the coil winding and is connected therearound by the end portions to *substantially* completely enclose the coil winding [see figure 11].

Witchger discloses the instant claimed invention except for a connection member being integrally formed with one of the bobbin flanges.

Sugiura et al. discloses a bobbin [11] having an end flange [11a] integrally supporting external connection member [12] and a cover [20] having a terminal protection portion [21] integrally formed therewith.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to mount the external connection members of Witchger on the flange of the bobbin, as suggested by Sugiura et al., for the purpose of facilitating connections of the leads and placement of the cover.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the coil assembly of Witchger, as modified, in conjunction with the cover in a ballast for the purpose of protecting a ballast winding from external contamination.

3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Witchger in view of Sugiura et al. as applied to claims 3 and 5 above and further in view of Leach et al. [US 4,363,014].

Witchger, as modified, discloses the instant claimed invention except for the end portions of the cover are interconnection by means of a snap connection.

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Leach et al. discloses a snap connection means [66] for a bobbin cover [14].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a snap connection means for the end portions of the cover of Witchger, as modified, as taught by Leach et al., for the purpose of easily assemble and dis-assembly the bobbin cover to the bobbin.

(11) Response to Argument

Applicant argues that:

[1] The “whereby” term helps to define the claimed structure, i.e. that the cover [20] engages the coil base [10] and cooperates therewith to *substantially* completely enclose the coil windings;

[2] The term “substantially” has been used in the claims of thousands of U.S. patents, thereby evidencing the recognition by the Patent and Trademark Office of the validity of this term in a claim;

[3] None of the prior art of record has anything to do with any problems that exist in the art of electric ballasts and they are in non-analogous art to that of applicant’s invention;

[4] There is no reason to combine Witchger and Sugiura et al.;

[5] It is very difficult to arrange the resilient strip cover [31] of Witchger so as to cover the wire ends [21A, 22A] and the coil winding wire ends [12A, 12B] if external connection members of Witchger were mounted on the bobbin flange, as allegedly suggested by Sugiura et al.;

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[6] It would not have been obvious to modify Witchger by substituting the resilient strip cover [31] of Witchger with the teachings of Sugiura et al., to provide the connection member [12] of Sugiura et al. on the flange of the Witchger device. The combination of Witchger and Sugiura et al. would destroy the apparatus of Witchger;

[7] The end portions of Witchger resilient strip *do not connect* with each other;

[8] Leach et al. do not show the end portions of a bobbin cover connected with each other;
and

[9] If the ends of the strip of Witchger are connected with each other by a snap connection or otherwise, the tail end of the strip would not be free so as to be wrapped around the coil in the manner disclosed by Witchger.

The examiner disagrees.

Regarding [1], the "whereby" term rejection under 112 second paragraph is withdrawn.

Regarding [2], the "substantially" term rejection under 112 second paragraph is maintained because, the term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Regarding [3], in response to applicant's argument that Witchger in view of Sugiura et al. is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which

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the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the claimed invention and both Witchger and Sugiura et al. involve a cover structure for a winding assembly. Applicant has not claimed any specific structure regarding the application of the winding assembly, but rather the winding assembly itself.

Regarding [4], Sugiura et al. discloses a one piece assembly to cover both a winding and terminal assembly. Witchger discloses a cover with the claimed wrapped around design also including cover terminals. A skilled artisan would have been highly motivated to combine the one piece teaching of Sugiura et al. with the cover design of Witchger.

Regarding [5], applicant merely claims the ballast further comprise “a *separate insulating synthetic resin cover [20] which includes as a part thereof an external insulator [25] which engages said connection member [250] of the coil base [10].*” Witchger discloses a resilient cover engaging the coil terminals. Sugiura et al. discloses a cover including a terminal cover slidably mounted thereon.

Regarding [6], Witchger discloses the terminals [21A, 22A] being mounted on an external portion of the resilient cover [31]. Sugiura et al. discloses terminals being mounted on a flange of a bobbin and a cover [20, 21] covering both the winding and terminals. To add the terminal cover of Sugiura et al. for the resilient cover of Witchger would not destroy the reference as that both Witchger and Sugiura et al. disclose the terminal cover being mounted an external portion of the winding cover.

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Regarding [7], Witchger discloses the end portions of the resilient strip [31] connected with each other [see column 3, lines 27-35].

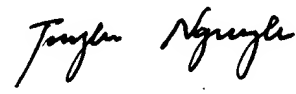
Regarding [8], Leach discloses a snap fit connection. A skilled artisan would have been highly motivated to use the snap connection design of Leach to connect the resilient strip.

Regarding [9], if the snap connection were to be used in Witchger, the tail end portions of the resilient strip would still be FREE so as to enable the resilient strip to be wrapped around the winding assembly.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


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